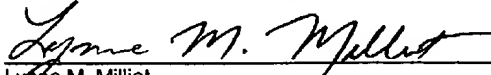


Atty Docket No.: PUMA 1024-1

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Lynne M. Milliot

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Eric O. BODNAR

Application No. 09/369,490

Confirmation No. 6852

Filed: 05 August 1999

Title: **System and Method for Embedding a
Context-Sensitive Web Portal in a
Computer Application**

Group Art Unit: 2131

Examiner: Syed ZIA

CUSTOMER NO. 22470

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Alexandria, VA 22313-1450

TRANSMITTAL OF NOTICE OF APPEAL

Sir:

In connection with the above-referenced U.S. patent application, transmitted
herewith are the following papers:

- [X] **Pre-Appeal Brief Request for Review (PTO/SB/33);**
- [X] **Notice of Appeal (PTO/SB/31); and**
- [X] **Credit Card Payment Form (PTO-2038) authorizing a charge of \$500 in payment
of the filing fee for a Notice of Appeal.**

The Commissioner is hereby authorized to charge any underpayment of fees, or
credit any overpayment, to our Deposit Account No. 50-0869 (Attorney Docket No. PUMA
1024-1).

Respectfully submitted,


Ernest J. Beffel, Jr., Reg. No. 43,489

Dated: 14 December 2005

HAYNES BEFFEL & WOLFELD LLP
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Half Moon Bay, CA 94019
Telephone: (650) 712-0340
Facsimile: (650) 712-0263

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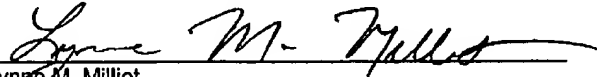
PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>43,489</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u><i>Ernest J. Beffel Jr.</i></u> Signature <u>Ernest J. Beffel, Jr.</u> Typed or printed name <u>(650) 712-0340</u> Telephone number <u>14 December 2005</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Atty Docket No.: PUMA 1024-1

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Lynne M. Milliot

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

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Group Art Unit: 2131

Examiner: Syed ZIA

CUSTOMER NO.: 22470

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed 19 September 2005, Applicant submits this Pre-Appeal Brief request for conference review, under the PTO's pilot program.

Application No.: 09/369,490

Atty Docket No.: PUMA 1024-1

REMARKS

Claims 89-106 are currently pending in this application.

Rejection of independent claims 89 and 98 under § 102(e) is clearly erroneous because (1) the Butler reference teaches something entirely different for what is claimed and (2) specific claim elements were explicitly identified that are not present in Butler.

The Technologies Taught by the Disclosure and Reference are Entirely Different

This application discloses a client-side application with a specially adapted embedded browser. This combination receives web pages with specially encoded instructions. "Special key tags" encode instructions in a web page to be processed by the parent application; other parts of the same web page are to be displayed by the embedded browser. Following instructions of the special key tags, the parent application may perform any of a wide variety of tasks identified in the specification and dependent claims, such as invoking a configuration dialogue (claim 92) or modifying a system registry entry for the parent application (claim 93).

The Butler reference, U.S. Patent 6,771,743, provides a server-side application that eliminates the need for a client-side browser. It discloses a voice processing server for use with ordinary telephones – not the new-fangled vision cell phones that run browsers, just plain-old-telephones (POTs). Butler's abstract describes:

A voice processing system, method and computer program product therefor, allows **telephone callers without computers to access World Wide Web** pages from the Internet. Usual graphical-based Hyper-Text Mark-Up language (HTML) commands are interspersed with special HTML tags including the commands and data for forming a voice application, which, when run on the voice processing system, provides a voice browser for allowing telephone callers to access Web pages. ...

The Butler voice processing server renders dual-format web pages audibly to anonymous telephone callers. We refer to the web pages as dual-format because they include both the standard HTML that is interpreted by a browser and a second set of commands or links that are ignored by browsers but used by the voice processing server to render the web page audibly. Butler's server allows callers with a standard telephone that has no display or browser to hear the audible track of dual-format web pages.

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Separately, for administrative purposes, an authenticated (NOT anonymous) sys admin using a computer instead of a telephone can access a graphical interface to configure and control Butler's voice processing server. The unremarkable sys admin interface is not a novel feature of Butler's invention and is not accessible to an anonymous telephone caller during audible rendering of a web page.

Applicant's response (AR) mailed June 14, 2005, before the Final Office Action (FOA), stressed the great and substantial differences between what Applicants disclosed and Butler's voice processing server. (AR 5-7) The Examiner (see, FOA 2-4) overlooked Applicant's description of Butler's technology and refutation of rejection under § 102(e); the Examiner only addressed the application of § 103(a) to dependent claims. (FOA 3) Perhaps, the great and substantial differences leave the Examiner with nothing to say. There is no way to read Butler's voice processing server on these claims. The rejections under § 102(e) inevitably will be reversed on appeal.

Explicitly Identified Claim Limitations

Applicant (AR 5-7) expressly identified and quoted limitations that Butler does not include. **Independent claim 89** includes the limitations:

the parent application intercepting a web page sent from the web server to the embedded browser, the web page including one or more special key tags encoded with instructions to the parent application, wherein the special key tags are not HTML formatting tags;

the parent application responding to the encoded instructions by triggering a special behavior of the parent application, distinct from displaying the web page; and

the embedded browser displaying at least part of the web page other than the special key tags

These limitations are not found in Butler. First, Butler's voice processing system is not architected as an application program with an embedded browser, both modules processing parts of the same web page. After all, Butler describes a server that allows a telephone handset to audibly reproduce web pages, without any browser at all. The voice processing server is remote to the telephone caller client. The ordinary telephone does not require an embedded browser to hear audibly rendered content. Butler does not attribute to the ordinary telephone either a parent application or an embedded browser.

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Second, assuming, *arguendo*, that the voice processing server runs a parent application, the parent application does not have an embedded browser. The voice processing server interface that the Examiner refers to is an administrative interface that is accessed from a different computer than the voice processing server (or at least, runs as an independent process.) Accessing an administrative interface to a server using a browser running on a different computer does not read on a parent application with an embedded browser.

Further, assuming, *arguendo*, that Butler combines a parent application with an embedded web browser, Butler discloses a voice processing server that discards the standard HTML of a dual-format web page and uses only audible coded information to render the web page to a telephone handset. The part of the web page other than the special key tags is thrown away, not displayed.

None of the limitations of claim 89 are met. The § 102(e) rejection should be withdrawn and the claim allowed.

Independent claim 98 includes the limitations:

computer-implemented logic adapted to:

intercept a web page from the web server addressed to the embedded browser, the web page including one or more special key tags encoded with instructions to the parent application, wherein the special key tags are not HTML formatting tags;

trigger special behavior of the parent application in response to the encoded instructions, distinct from displaying the web page; and

pass to the embedded browser at least part of the intercepted web page for the embedded browser to display

These limitations are not found in Butler, for the reasons given above.

Therefore, claim 98 should be allowed.

For reference, we point out that dependent claims 90-93 and 96-97 include limitations such as:

(90) further including the parent application removing the special key tags from the web page and passing the revised web page to the embedded browser for display.

(92) further including, as the special behavior of the parent application, presenting a set-up dialogue to configure the parent application.

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(96) further including, as the special behavior of the parent application, customizing the web page with user-specific information accessible to the parent application and not provided in the intercepted web page.

(97) further including, as the special behavior of the parent application, invoking a handler routine responsive to instructions in auxiliary information that is part of the special key tags.

These limitations further define special behaviors of the parent application that are responsive to special key tags. Each of these claims have improperly been rejected under § 102(e) based on Butler, which is not even similar to the claimed inventions, much less including these detailed limitations.

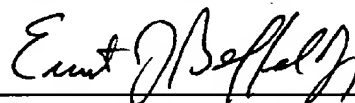
Other dependent claims are allowable for reasons given in the previously filed AR.

CONCLUSION

Applicant respectfully submits that the pending claims should be allowed without full briefing by Applicant and the Examiner. We have gone back and forth in the application enough times for the best art to be in front of us and for the decision to be made to allow the claims.

Applicant would welcome an interview, if the conference is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,



Ernest J. Beffel, Jr., Reg. No. 43,489

Dated: 14 December 2005

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